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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,323	08/13/2001	Mikio Kondo	212464US0X CIP	5148
22850	7590	10/19/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			MAI, NGOCLAN THI	
			ART UNIT	PAPER NUMBER
			1742	
DATE MAILED: 10/19/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/927,323	Applicant(s)  KONDO ET AL.	
	Examiner Ngoclan T. Mai	Art Unit 1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6,7 and 9-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6,7 and 9-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/27/05</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-3, 6-7, 9-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 recites "a die which is heated to the melting point or less of said higher fatty acid lubricant". There is no support for the die being heated to the melting point, i.e., at the melting point of the higher fatty acid lubricant. Additionally, the specification at paragraph [0058] teaching away from heating the die at (and above) the melting point of the lubricant.

Response to Arguments

3. Applicant's arguments, see page 8, lines 3-14, page 9, lines 25-24, and page 10, lines 5-9 filed 7/27/05, with respect to claims 1-3, 5-7, 9-13 as being rejected under 35 U.S.C. 103 have been fully considered and are persuasive. The rejections of these claims as being unpatentable over Harada in view of Koenig et al. and Inculet et al., Inculet et al. in view of Cadle et al., and Tsuchida et. al. in view of Cadle et al. and further in view of Koenig et al. and Inculet have been withdrawn.
4. Applicant's arguments filed 7/27/05 have been fully considered but they are not persuasive. Applicant essentially argues the difference between the amended claim 1 and Harada et al and fails to address the limitations of claims 14-15 which only requires that the application of a metal salt of higher fatty acid to an inner surface of a die heated to 100 deg C or more and charging iron powder into said die

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and compacting said iron powder at a pressure of 600 Mpa or more. As indicates in the rejection in the previous office action JP discloses a powder molding method where the surface of a molding die is heated to a temperature in the range of 150-400 C and coated with a lubricant such as zinc stearate, which is a higher fatty acid, see page 6, [0017] and the molding pressure for molding the green compact disclosed is set at 7 ton/cm² or 686 MPA, see page 10 [0033] and page 13 [0043].

5. Applicant's arguments, see page 9, lines 15-24, filed 7/27/05, with respect to claims 18-23 have been fully considered and are persuasive. The rejection of these claims has been withdrawn.

However, with regarding claims 14-17 being rejected under 35 USC 103 over Inculet et al. in view of Cadle et al., applicant fails to point out the difference between these claims and the prior art. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., applying the lubricant per se to the inner surface of the die heated to a temperature between the softening temperature and the melting temperature of the lubricant of compacting under such pressure that the lubricant is chemically bonded with the metal powder to form a metallic soap coating which is different from the lubricant) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). As stated in previous office action, paragraph 5, Inculet et al in view of Cadle et al teach at least the limitations of claims 14-17.

6. With regarding to claims 14-22 being rejected under 35 U.S.C. 103 over Tsuchida et al in view of Cadle et al and claim 23 over Tsuchida et al in view of Cadle et al and further in view of Koenig et al. and Inculet et al, applicants essentially argue that in Tsuchida et al's method the compacting temperature is higher than the melting point of the lubricant and that Tsuchida et al discloses disadvantages in compacting at a temperature below the melting point of the lubricant, thus Tsuchida et al teaches away from the presently claimed invention. This is not persuasive because the feature upon which applicant relies (compacting temperature higher than lubricant temperature) is not excluded from the presently claimed invention. In another word there is nothing the in the claims to indicate that the compacting is

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performed at temperature lower than the melting temperature of the lubricant. Therefore claims 14-22 are taught by Tsuchida et al in view of Cadle et al and claim 23 by Tsuchida et al in view of Cadle et al and further in view of Koenig et al. and Inculet et al as indicated in previous office action per paragraphs 7 and 8.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoclan T. Mai whose telephone number is (571) 272-1246. The examiner can normally be reached on 9:30-6:00 PM Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Ngoctan T. Mai
Primary Examiner
Art Unit 1742

n.m.